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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/451,442	11/30/1999	KENJI MIKAMI	35.C14160	9073

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EXAMINER

JONES, DAVID

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 03/16/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/451,442

Applicant(s)

MIKAMI ET AL. *mn*

Examiner

David L Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 10-14, 16, 17, 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 15 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ✓
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 9/11/2000 was filed after the mailing date of the application on 11/30/1999. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. Further, in the previous office action dated 9/26/03, it was noted that the IDS was placed in the record, but not considered, applicant's remarks were duly noted, that no copy of a US application need be provided prior to 7 November 2000, and affirmed in this regard, and therefore as acknowledged above the IDS was considered.

### ***Response to Amendment***

2. Applicant's amendment was received on 12/24/2003, and has been entered and made of record. Currently, claims 1-9, 15, and 18 are pending, applicant canceled claims 10-14, 16-17, and 19-20, and therefore they are withdrawn from further consideration.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-9, 15, and 18 have been considered but are moot in view of the new ground(s) of rejection.

4. Applicant's arguments, see amendment A, filed 12/24/03, with respect to rejections under 35 USC 112 have been fully considered and are persuasive. The rejections of claims 1, 4, 15, and 18 have been withdrawn.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-9, 15, and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Mizuno et al. (US 6,426,800) and further in view of Nakamura et al. (US 5,339,134).

**Regarding claim 1**, Mizuno et al. discloses a data processing apparatus comprising:

instruction input unit, arranged to input a manual instruction by the operator (Fig. 3, #75, column 7, lines 28-51);

process unit (Fig. 3, #74), arranged to execute a predetermined process based on the input by said instruction input unit;

connection unit (Fig. 3, #101 & 78), arranged to connect with an external device;

display unit (Fig. 12, #30, digital copy machine, column 13, lines 28-44), arranged to display information through the CPU 74 (control unit), based on data received from the PC #4, and the liquid crystal video camera through said connection unit, and further as detailed that when "n" pieces of image data recorded in the liquid crystal video camera are composed into a single image and when the digital copying machine 30 carries out an image-forming process on this image based on the size and the number of sheets of paper that have been set by the personal computer. In addition, with respect to a judgment made as to whether or not the settings are appropriate, the CPU 74, may be arranged so that it calls for judgment of the external-input

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apparatus (column 14, lines 1-9), therefore it would have been obvious to one skilled in the art at the time the invention was made that when the CPU asks for judgment that it would display that on the screen of the PC and wait for an answer, further, in lines 31-39, it is shown that input operations is transmitted or received are carried out in digital image forming apparatus, which as detailed above would be done on the operational panel LCD screen;

discrimination unit (column 11, lines 30-49, CPU #74), arranged to discriminate whether the input by said instruction input unit has not been executed, and further, since the connecting state of the external input-output device is automatically recognized, it is not necessary to manually input the connecting state of the external input-output device, the input operations related to processing of image data that is transmitted or received to or from the external input-output device are carried out merely through operations in the digital image-forming apparatus, the external input-output device that has been connected can be visually recognized and confirmed, and operations related to function selection can be promptly carried out with ease.

Mizuno does not explicitly detail that there would be a function completed in a predetermined period after an instruction has been inputted.

Whereas, Nakamura et al. teaches that an image forming apparatus (fig. 1, column 6, lines 11-31) that comprises: a main control unit 10 that contains a CPU 11, the CPU is connected through an interface connection to the console panel 30 through which data and control signals are inputted by the user. Nakamura teaches that AUX I/F receives and sends data from/to an external device, for example a host computer. In column, 13, lines 53-67, and column 14, lines 1-10, through the main control unit, detects if there are documents on the ADF (fig. 2, #106), the display section 32a of the display panel 32 displays instructions to select

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either an input or search function, and the system is maintained in the standby state for a predetermined period of time, e.g. one minute. At the same time, an overtime is checked by measuring a time elapsed after the system has been set in the standby state. When the predetermined period elapses the filing mode is switched to the copying mode and is displayed on the display section.

Therefore, at the time of the invention, it would have been obvious to one skilled in the art to combine the notification on the display after a predetermined period of Nakamura on the PC of Mizuno.

The suggestion/motivation for doing so would have been to provide the user with notification to input a further action after a predetermined period.

Therefore, it would have been obvious to combine Mizuno with Nakamura to obtain the invention as specified in claim 1.

**Regarding claim 2**, Mizuno et al. discloses a data processing apparatus, wherein the LCD display displays a display image frame different for each process function executed by said process means, and said control means controls the display based on the data received from the external device through said connection means, according to the display image frame for which the information is intended (Fig. 5, column 9, lines 4-18).

**Regarding claim 3**, Mizuno et al. discloses a data processing apparatus, wherein said display means is adapted to display a display image frame of information based on the data received from the external device through said connection means and an operation image frame for input by said instruction input means (column 10, lines 35-60).

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**Regarding claim 4**, Mizuno et al. discloses a data processing apparatus, wherein said display means is adapted to display, a first display information to be displayed in place for the operation image frame for input by said instruction input means, based on the data received from the external device through said connection means, and a second display information to be displayed in the operation image frame (column 10, lines 35-60).

**Regarding claim 5**, Mizuno et al. discloses a data processing apparatus, wherein said control means receives data for the information to be displayed by said display means, and executes reception from the external device through said connection means. It would have been obvious to one skilled in the art at the time the invention was made that the information received from the external device would flow through the MIB utilizing SNMP (simple network management protocol). Note, that by definition SNMP provides for the communication of status and setup information between a management console and a managed device using values of objects defined in the MIB for the managed object.

**Regarding claims 8 and 9**, Mizuno et al. discloses a memory (column 7, lines 21-27) whereby storage of data can be accomplished and a display with control means, but does not disclose that it would indicate the status of a file and to display different colors depending on the attributes of that file. Although, Mizuno et al. does not disclose the afore mentioned it would be obvious at the time the invention was made by one skilled in the art to include file status and to add color differentiation for file attributes and for information prioritization, thereby delineating the information of each file and the priority of incoming information.

**Regarding claim 15**, Mizuno et al. discloses a control method for a data processing apparatus capable of executing a predetermined process based on a manual instruction by the operator and displaying various information on a display device, comprising:

a reception step (column 13, lines 28-44) of receiving data transmitted from an external device;

a discrimination step (column 11, lines 30-49, CPU #74), arranged to discriminate whether the input by said instruction input unit has not been executed, and further, since the connecting state of the external input-output device is automatically recognized, it is not necessary to manually input the connecting state of the external input-output device, the input operations related to processing of image data that is transmitted or received to or from the external input-output device are carried out merely through operations in the digital image-forming apparatus, the external input-output device that has been connected can be visually recognized and confirmed, and operations related to function selection can be promptly carried out with ease.

Mizuno does not explicitly detail that there would be a function completed in a predetermined period after an instruction has been inputted.

Whereas, Nakamura et al. teaches that a image forming apparatus (fig. 1, column 6, lines 11-31) that comprises: a main control unit 10 that contains a CPU 11, the CPU is connected through an interface connection to the console panel 30 through which data and control signals are inputted by the user. Nakamura teaches that AUX I/F receives and sends data from/to an external device, for example a host computer. In column, 13, lines 53-67, and column 14, lines 1-10, through the main control unit, detects if there are documents on the ADF (fig. 2, #106),



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the display section 32a of the display panel 32 displays instructions to select either an input or search function, and the system is maintained in the standby state for a predetermined period of time, e.g. one minute. At the same time, an overtime is checked by measuring a time elapsed after the system has been set in the standby state. When the predetermined period elapses the filing mode is switched to the copying mode and is displayed on the display section.

Therefore, at the time of the invention, it would have been obvious to one skilled in the art to combine the notification on the display after a predetermined period of Nakamura on the PC of Mizuno.

The suggestion/motivation for doing so would have been to provide the user with notification to input a further action after a predetermined period.

Therefore, it would have been obvious to combine Mizuno with Nakamura to obtain the invention as specified in claim 15.

**Regarding claim 18**, Mizuno et al. discloses a CPU and a memory section that contains RAM and/or hard disk (column 7, lines 21-27), (Note: commonly known as a computer memory medium, and it would be inherent that it would contain any type of operating programs) which are used for controlling the data processing apparatus capable of executing a predetermined process based on a manual instruction by the operator and displaying various information on a display device, the program comprising: a reception step of receiving data transmitted from an external device (column 14, lines 31-39); a discrimination step of discriminating whether the input of the instruction by the operator has not been executed (column 11, lines 30-49); and a control step of causing said display device to execute display information based on the data received in said reception step (column 14, lines 11-30).

Mizuno does not explicitly detail that there would be a function completed in a predetermined period after an instruction has been inputted.

Whereas, Nakamura et al. teaches that a image forming apparatus (fig. 1, column 6, lines 11-31) that comprises: a main control unit 10 that contains a CPU 11, the CPU is connected through an interface connection to the console panel 30 through which data and control signals are inputted by the user. Nakamura teaches that AUX I/F receives and sends data from/to an external device, for example a host computer. In column, 13, lines 53-67, and column 14, lines 1-10, through the main control unit, detects if there are documents on the ADF (fig. 2, #106), the display section 32a of the display panel 32 displays instructions to select either an input or search function, and the system is maintained in the standby state for a predetermined period of time, e.g. one minute. At the same time, an overtime is checked by measuring a time elapsed after the system has been set in the standby state. When the predetermined period elapses the filing mode is switched to the copying mode and is displayed on the display section.

Therefore, at the time of the invention, it would have been obvious to one skilled in the art to combine the notification on the display after a predetermined period of Nakamura on the PC of Mizuno.

The suggestion/motivation for doing so would have been to provide the user with notification to input a further action after a predetermined period.

Therefore, it would have been obvious to combine Mizuno with Nakamura to obtain the invention as specified in claim 18.

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7. Claims 6-7 rejected under 35 U.S.C. 103(a) as being unpatentable over Mizuno et al. and Nakamura et al. as applied to claim 1-5, 8-9, 15, and 18 above, and further in view of Harkins et al. U.S. Patent 5,513,126.

Regarding claims 6-7, Mizuno et al. discloses a control system whereby a plurality of devices can be connected and remotely operated. Nakamura et al. teaches a system of an image forming apparatus that includes the ability to scan, save, file and interact with an external device, such as host computer. Mizuno et al. and Nakamura et al. do not explicitly disclose the use of any type of email operation.

Whereas, Harkins et al. discloses an email system (column 6, lines 4-22) incorporated within the system.

Therefore, it would have been obvious at the time the invention was made to incorporate the device by Mizuno et al. and Nakamura et al. to include the system by Harkins et al. thereby allowing operation of system to operate through electronic mail data (email) (Note: Emails systems work predominately on SMTP or POP systems).

The suggestion/motivation for doing so would be method for a sender to automatically distribute information to a receiver on a network using devices, such as printers and facsimile devices, and communication channels, such as electronic mail (column 4, lines 39-55).

Therefore, it would have been obvious to combine Mizuno and Nakamura with Harkins to obtain the invention as specified in claims 6 and 7.

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*Conclusion*

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


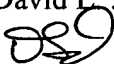
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L Jones whose telephone number is (703) 305-4675. The examiner can normally be reached on Monday - Friday (7:00am - 3:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David L Jones



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